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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,967	10/01/2003	Adrian Mark Chandley	MSFT-2783/305412.01	8125
41505	7590	02/15/2006	EXAMINER	
WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)			NGUYEN, NAM V	
ONE LIBERTY PLACE - 46TH FLOOR				
PHILADELPHIA, PA 19103			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/676,967	CHANDLEY, ADRIAN MARK	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nam V. Nguyen	2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10/01/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/03;7/05,10/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The application of Chandley for a “systems and methods for deterring theft of electronic devices” filed October 1, 2003 has been examined.

Claims 1-38 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-21 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 13 and 38, the phrase “in response to a timeout condition” is confusing and unclear. It is not understood what is meant by such a limitation. What a timeout condition? What is the condition for a timeout? Where is this limitation supported by specification?

Referring to claims 14-21 are rejected as being dependent upon a rejected Claim 13 above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9-12, 22-23, 25-30 and 36-37 are rejected under 35 U.S.C. 102(b) as being anticipated by McCarthy (US# 6,087,937).

Referring to claims 1, 22, 28 and 37, McCarthy discloses a security device as recited in claim 1. See Figures 1 to 5 and respective portions of the apparatus and method.

McCarthy discloses an electronic device and a method for deterring theft of electronic devices (10) (i.e. a personal computer) (column 1 line 65 to column 2 line 56; see Figures 1 to 5), comprising:

in response to an indication that a device (10) (i.e. a personal computer) is lost (i.e. a customer calls the service provider and identify their personal computer that has been stolen), receiving by a receiver (22) of the device (10) a disabling signal targeting the device (10) remotely via a network (i.e. a telecommunications provider) (column 3 lines 47 to 62; see Figures 1 to 5); and

in response to receiving the disabling signal, electronically disabling the device (10) via a component (14) (i.e. a display screen) of the device (10) that cannot be removed without destroying the device (10) (column 3 lines 59 to 67; see Figures 1 to 5).

Referring to claims 2, 23 and 29, McCarthy discloses a security device as recited in claims 1, 22 and 28, wherein the network is at least one of a wireless network (column 3 lines 47 to 54; see Figure 4).

Referring to claims 3 and 30, McCarthy discloses a security device as recited in claims 1 and 28, further comprising: in response to receiving the disabling signal, displaying a message (i.e. "STOP! this computer is stolen, contact the police") via a display (14) of the device (10) (column 3 lines 56 to 67; see Figures 1 to 5).

Referring to claims 9, 25 and 36, McCarthy discloses a security device as recited in claims 1, 22 and 28, further including transmitting said disabling signal at least one of as plain text (column 2 lines 26 to 33; see Figure 4).

Referring to claims 10-12 and 26-27, McCarthy discloses a security device as recited in claims 1 and 22, McCarthy discloses a computer readable medium, a computing device and a modulated signal comprising computer executable modules having computer executable instructions for carrying out the method of claims 1, 13 and 22 (column 1 line 65 to column 2 line 56; see Figures 1 to 5).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 8, 31-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (US# 6,087,937) as applied to claims 1 and 28 above, and in view of Chesnutt (US# 5,966,081).

Referring to claims 4 and 31, McCarthy discloses a security device as recited in claims 1 and 22, however, McCarthy did not explicitly disclose wherein said disabling includes electronically disabling the device by changing the status of at least one connection in the device from one of (a) open to closed and (b) closed to open.

In the same field of endeavor of antitheft system in a portable consumer electronic, Chesnutt teaches that disabling includes electronically disabling the device (12) (i.e. a laptop computer) by changing the status of at least one connection in the device (12) from one of (a) open to closed and (b) closed to open (column 3 lines 20 to 47; see Figures 1 to 3) in order to put the computer system not to be operated.

One of ordinary skilled in the art recognizes the need to trips an internal programmable switch or changes the state of a non-volatile memory cell in a laptop computer taught by Chesnutt in a stolen mobile communication security device of McCarthy because McCarthy

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suggests it is desired to provide that the display unit within the stolen computer changes the visual output on being activated by a remotely transmitted signal (column 2 line 45 to 56; column 3 lines 47 to 67; see Figures 3 to 5) and Chesnutt teach that the antitheft device receives the deactivation code and trips an internal programmable switch or changes the state of a non-volatile memory cell in the laptop (column 3 lines 20 to 39; see Figures 2) in order to have the laptop not to be operated when the laptop is stolen. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to trips an internal programmable switch or changes the state of a non-volatile memory cell in a laptop computer taught by Chesnutt in a stolen mobile communication security device of McCarthy with the motivation for doing so would have been to prevent theft from using the security device when such a security device is stolen.

Referring to claims 5 and 32, McCarthy discloses a security device as recited in claims 1 and 28, Chesnutt discloses wherein said disabling includes electronically disabling at least one subcomponent (70) (i.e. a post circuit) of the device (12) (column 3 lines 8 to 39; see Figures 2 and 3).

Referring to claims 6 and 33, McCarthy discloses a security device as recited in claims 1 and 28, Chesnutt discloses wherein said component (71) is a processor and said disabling includes electronically disabling the device (12) by disabling operation of at least a portion of the processor (71) (column 3 lines 8 to 39; see Figures 2 and 3).

Referring to claims 8 and 35, McCarthy discloses a security device as recited in claims 1 and 34, Chesnutt discloses further including locally entering a pre-defined code (i.e. re-enabling code) to the device (12) to re-enable operation of the device (12) (column 4 lines 49 to 60; see Figure 3).

Claims 7, 24 and 34, are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (US# 6,087,937) as applied to claims 1, 22 and 28 above, and in view of Struble et al. (US# 6,433,685).

Referring to claims 7, 24 and 34, McCarthy discloses a security device as recited in claims 1, 22 and 28, however, McCarthy did not explicitly disclose further comprising in response to receiving the disabling signal, transmitting information over at least one of (a) the network and (b) a second network to which the device is connected, said information providing a basis for resolving the location of the device.

In the same field of endeavor of antitheft system in a portable consumer electronic, Struble teaches that in response to receiving the disabling signal (i.e. a command signal), transmitting information (i.e. an article identification information) over at least one of the network (114) (i.e. a telecommunication network) which the device (202)(i.e. an article) is connected, said information providing a basis for resolving the location of the device (202) (column 2 line 11 to 28; column 6 line 64 to column 7 line 12; column 11 lines 33 to 53; see Figures 1 to 7) in order to locate a lost or stolen articles.



At the time of the invention, it would have been obvious to a person of ordinary skill in the art to recognize the need for transmitting an article identification information to a detector over a network for locating a stolen or lost article taught by Struble in an apparatus for inhibiting the theft of an electronic device of McCarthy because locating a stolen article would recovered by a law enforcement agencies and returned the recovered article to their rightful owners that has been shown to be desirable in the security device of McCarthy.

Claims 13-15, 20-21 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (US# 6,087,937) and in view of Jespersen (US# 6,577,239).

Referring to claims 13 and 38, McCarthy discloses a method for deterring theft of electronic devices (10) (i.e. a personal computer) (column 1 line 65 to column 2 line 56; see Figures 1 to 5), comprising:

in response to an indication that a device (10) (i.e. a personal computer) is lost (i.e. a customer calls the service provider and identify their personal computer that has been stolen), receiving by a receiver (22) of the device (10) a disabling signal targeting the device (10) remotely via a network (i.e. a telecommunications provider) (column 3 lines 47 to 62; see Figures 1 to 5); and

electronically disabling the device (10) via a component (14) (i.e. a display screen) of the device (10) that cannot be removed without destroying the device (10) (column 3 lines 59 to 67; see Figures 1 to 5).

However, McCarthy did not explicitly disclose in response to a timeout condition associated with receiving a message via a network.

In the same field of endeavor of antitheft system in a portable consumer electronic, Jespersen teaches that in response to a timeout condition (i.e. not receive enable signal within timeslot) associated with receiving a message (i.e. an enable signal) via a network (i.e. a mobile telephone network) (column 3 lines 25 to 34; see Figures 1 to 11) in order to trigger an alarm or to disable operation of the electronic apparatus.

One of ordinary skilled in the art recognizes the need to configure to disable operation of portable computers if an enable signal is not received from an external source and the counter timeouts taught by Jespersen in a stolen mobile communication security device of McCarthy because McCarthy suggests it is desired to provide that the display unit within the stolen computer changes the visual output on being activated by a remotely transmitted signal (column 2 line 45 to 56; column 3 lines 47 to 67; see Figures 3 to 5) and Jespersen teaches that the electronic apparatus is not receives an enabling signal and the counter timeouts, the controller set an alarm levels and disable operation of the electronic apparatus (column 3 lines 25 to 34) in order to prevent loss or theft of the electronic apparatus . Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to configure to disable operation of portable computers if an enable signal is not received from an external source and the counter timeouts taught by Jespersen in a stolen mobile communication security device of McCarthy with the motivation for doing so would have been to prevent theft from using the security device when such a security device is stolen.

Referring to claims 14-15 and 20-21, McCarthy and in view of Jespersen disclose a method for deterring theft of an electronic device as claimed in claim 13, the claims 14-15 and 20-21 same in that the claims 2-3 and 10-11 already addressed above therefore claims 14-15 and 20-21 are also rejected for the same reasons given with respect to claims 2-3 and 10-11.

Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (US# 6,087,937) and in view of Jespersen (US# 6,577,239) as applied to claims 13 above, and in further view of Chesnutt (US# 5,966,081).

Referring to claims 16-18, McCarthy and in view of Jespersen disclose a method for deterring theft of an electronic device as claimed in claim 13, the claims 16-18 same in that the claims 4-6 already addressed above therefore claims 16-18 are also rejected for the same obvious reasons given with respect to claims 4-6 above.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarthy (US# 6,087,937) and in view of Jespersen (US# 6,577,239) as applied to claim 13 above, and in further view of Struble et al. (US# 6,433,685).

Referring to claim 19, McCarthy and in view of Jespersen disclose a method for deterring theft of an electronic device as claimed in claim 13, the claim 19 same in that the claim 7 already addressed above therefore claim 19 also rejected for the same obvious reasons given with respect to claim 7 above.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Badger (US# 5,729,192) discloses a remote automobile disabler device and associated method.

Sasakura et al. (US# 6,151,493) disclose a device for prohibiting unauthorized use of electronic devices.

Parrott et al. (US# 6,618,580) disclose an apparatus and method for remotely power-down a wireless transceiver.

Kagay, Jr. (US# 6,782,251) discloses a method and apparatus for operating a lost mobile communication device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 571-272-3061. The examiner can normally be reached on Mon-Fri, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 571-272-3068. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nam Nguyen  
February 6, 2006

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Michael Horabik', is written over the printed name and title.